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EXAMINER

MA, JOHNNY

ART UNIT PAPER NUMBER

2614

DATE MAILED: 03/29/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/517,818

Applicant(s)

OZ ET AL.

Examiner

Johnny Ma

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,5,7,8 and 23-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-3,5,7,8 and 23-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The Final Rejection, Paper No. 10, mailed 7/17/2003 is vacated. Please note that this is a New Final Office Action, in lieu of applicant's arguments in Appeals Brief (Paper No. 14, filed 12/18/2003). Consequently this Office Action is being made Final as necessitated by Amendment A, filed 04/22/2003.

Response to Arguments

1. Applicant's arguments with respect to claims 23, 5, 7, 8, and 24-39 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 23, 2, 5, 7, 8, 24-33 and 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US 6,698,020 B1) in further view of Howe et al. (US 5,892,508).

As to claim 23, note the Zigmond et al. reference that discloses techniques for intelligent video ad insertion. The claimed "periodically downloading from a server selected data sets according to user profile information, the selected data sets representing information elements for display to a user during switching events" are met by "...a plurality of advertisements are

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periodically delivered to the ad insertion device and are stored therein in preparation for selection and display of one or more of the advertisements. Ad insertion device 80 may advantageously be a WebTV box” (Zigmond et al. 10:16-24). The claimed “displaying a first one of the information elements in response to initiation of a first switching event” is met by “[a]t the appropriate time indicated by the triggering event, the video programming feed is interrupted and the selected advertisement is displayed to the viewer using a display screen... Upon termination of the advertisement, the video programming feed is again displayed to the viewer” (Zigmond et al. 4:45-52). The claimed “discontinuing display of the first one of the information elements and displaying the data stream information from the server when it becomes available for such display” is met by the insertion of advertisements during designated advertisement breaks and returning to the video programming feed display at the end of such a break (Zigmond et al. 7:26-29). However, the Zigmond et al. reference is silent as to interactivity. Now note the Howe et al. reference that discloses a system and method for providing television services wherein advertisers may furnish interactive applications (Howe et al. 7:55-63). The claimed “unless the user has initiated an interactive transaction session with a remote host by selecting an interactive element associated with the first one of the information elements in which case displaying the data stream information from the server is delayed until termination of the interactive transaction session or expiration of a predetermined period of inactivity by the user” is met by set top box displaying an “icon” or “button” on video screen to indicate interactivity availability, upon seeing the button or icon the user may request an interactive session resulting the processor first storing the identity of the channel on which the program then being viewed is transmitted and then switching to the interactive session (Howe et al. 4:29-59) and when the interactive session is

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terminated, the processor retunes receiver to the first program to which the viewer had been tuned (Howe et al. 5:8-14). Particularly, the claimed delaying display of the data stream is met by the system retuning to the data stream channel (program channel) only after the interactive session has been terminated. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Zigmond et al. advertisements with the Howe et al. interactivity for the purpose of informing a user of the availability of an interactive application relating to the subject matter of a commercial and invoke the application to investigate that subject matter more thoroughly and according to his or her own tastes (Howe et al. 2:48-54).

As to claim 2, the claimed wherein downloading the selected data sets comprises storing the selected data sets in buffer of a digital set top box. Note the Zigmond et al. reference discloses the storage of advertisements in memory. However, the Zigmond et al. reference is silent as to the use of a buffer. Nevertheless, the examiner gives Official notice that it is notoriously well known in the art of video display to store video data in a buffer purpose of providing quick access to data to be inserted thus ensuring seamless video segment transitions. Accordingly, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Zigmond et al. display of advertisements stored in memory with the notoriously well known uses of a buffer for the purpose of providing a method for memory management and the above stated advantages.

As to claim 5, the claimed wherein downloading the selected data sets comprises storing those of the selected data sets associated with the first information element in a buffer of a digital set top box and storing others of the selected data sets associated with others of the information

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elements in a memory of the digital set top box, wherein corresponding ones of the others of the selected data sets stored in the memory of the digital set top box replace those of the selected data in the buffer of the digital set top box once the first information element is displayed. The Zigmond et al. reference discloses the storage of advertisements in memory. However, the Zigmond et al. reference is silent as to the use of a buffer. Nevertheless, the examiner gives Official notice that it is notoriously well known in the art of video display to employ a buffer coupled to memory for the purpose of providing quick access to data to be inserted thus ensuring seamless video segment transitions. Accordingly, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Zigmond et al. display of advertisements stored in memory with the notoriously well known uses of buffer queue for the purpose of providing a method for memory management and the above stated advantages.

As to claim 7, the claimed “wherein the first information element comprises data associated with the data stream information from the server” is met by “[selecting] an advertisement according to the subject matter of a particular program” (Zigmond et al. 12:60-62)

As to claim 8, the claimed “wherein the first information element comprises advertising data selected in accordance with the user profile information” is met by “[t]he advertisements to be shown to a viewer according to the invention are selected according to designated criteria in combination with information that characterizes the viewer...” (Zigmond et al. 6 :5-11).

As to claim 24, the claimed “wherein downloading the selected data sets comprises storing the selected data sets in a digital set top box in which the user profile information is stored” is met by “...special purpose computer embodying the ad insertion device 60 is

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a...WebTV box” wherein advertisements are pre-filtered so that advertisements are stored according to the ad selection criteria stored at storage location 83 (Zigmond et al. 15:17-23).

As to claims 25 and 26, the claimed wherein the user profile information is stored at the server and wherein the user profile information is stored in a data source accessible by the server. The Zigmond et al. reference discloses storing viewer preference information. However, the Zigmond et al. reference is silent as to profile information stored at the server or on a data source accessible by the server. Nevertheless, the examiner gives Official Notice that it is notoriously well known in the art to store profile information at a server or an external source accessible by a headend such as a external user profile database in order to provide a centralized storage of user profile information. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Zigmond et al. reference accordingly for the purpose of providing targeted advertisements where the profile is stored in a location other than the set top box to broadcast local content that may be of interest to a wider audience using user statistics and at a more centralized location.

As to claim 27, the claimed wherein the data stream information is also stored in the data source is met by “...video programming feed 52 may be provided by a national broadcaster, a local affiliate, a cable network, satellite broadcast network...video tape or any other medium carrying recorded video programming” (Zigmond et al. 7 :5-12).

As to claim 28, the claimed “wherein the remote host comprises an Internet host and the interactive transaction session comprises an electronic shopping transaction. Note, the Zigmond and Howe combination teach the display of interactive advertisements. However, the Zigmond and Howe combination does not specifically teach an electronic purchase. Nevertheless, the

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examiner gives Official Notice that it is notoriously well known in the art of commercial interactivity to provide a user with the capability to interactively purchase an advertised item via an Internet Host for the purpose of providing a seller with the ability to complete a sales transaction when the content of an advertisement has the most effect on a user thus improving an advertiser's product sales. Accordingly, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Zigmond and Howe interactive advertisements accordingly for the above stated advantages.

As to claim 29, the claimed "wherein the user profile information is based on one or more of: the user's television viewing habits, the user's purchasing habits, and the user's use of one or more television services" is met by "...ad selection criteria may further be used to choose advertisements that are compatible with television viewing habits of the viewer, the preferred Internet or World Wide Web sites, previous Internet purchases made using the home entertainment system... and the like" (Zigmond et al. 13:7-12).

As to claim 30, the claimed "wherein the information elements comprise one or more of: advertisement, information regarding the data stream information, information regarding a television program, information regarding a television channel, personal information regarding the user, a segment of the data stream information, or local or regional information" are met by the Zigmond et al. advertisements, please see rejection of claim 23.

As to claim 31, note the Zigmond et al. reference that discloses techniques for intelligent video ad insertion. The claimed "server configured to provide a data stream transmission" is met by content providers transmitting video programming feeds "...via any suitable program delivery channel, such as an over-the-air broadcast, a cable provider, a consumer satellite service,

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telephone lines, via the Internet, or by any other system for transmitting video data” (Zigmond et al. 7:16-21). The claimed “digital set top box” is met by the disclosed WebTV box (Zigmond et al. 7:42-49). The claimed “periodically download from the server selected data sets according to user profile” is met by “...a plurality of advertisements are periodically delivered to the ad insertion device and are stored therein in preparation for display...” (Zigmond et al. 10:16-24) wherein “...advertisements are filtered by ad filter device 84 according to the ad selection criteria [user preference information] stored at storage location 83” (Zigmond et al. 15:17-23). The claimed “the selected data sets being included within the data stream and representing information elements for display to a user during switching events” is met by the receiving of advertisements “...may include any other advertisement deliver channel...or any other system for transmitting video data” (Zigmond et al. 15:8-16) and the in-band transmission of advertisements (Zigmond et al. 16:11-15,46-51). The claimed “display a first one of the information elements in response to initiation of a first switching event” is met by “[a]t the appropriate time indicated by the triggering event, the video programming feed is interrupted and the selected advertisement is displayed to the viewer using a display screen... Upon termination of the advertisement, the video programming feed is again displayed to the viewer” (Zigmond et al. 4:45-52), where the examiner considers a switching event to consist of programming, switching to a commercial, and switching back to programming. The claimed “discontinue the display of the first one of the information elements and displaying the data stream information from the server when it becomes available for such display” is met by the insertion of advertisements during designated advertisement breaks and returning to the video programming feed display at the end of such a break (Zigmond et al. 7:26-29) where the end of a commercial

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break is when display of the data stream information becomes available again. However, the Zigmond et al. reference is silent as to interactivity. Now note the Howe et al. reference that discloses a system and method for providing television services wherein advertisers may furnish interactive applications (Howe et al. 7:55-63). The claimed "unless the user has initiated an interactive transaction session with a remote host by selecting an interactive element associated with the first one of the information elements in which case displaying the data stream information from the server is delayed until termination of the interactive transaction session or expiration of a predetermined period of inactivity by the user" is met by set top box displaying an "icon" or "button" on video screen to indicate interactivity availability, upon seeing the button or icon the user may request an interactive session resulting the processor first storing the identity of the channel on which the program then being viewed is transmitted and then switching to the interactive session (Howe et al. 4:29-59) and when the interactive session is terminated, the processor retunes receiver to the first program to which the viewer had been tuned (Howe et al. 5:8-14). Particularly, the claimed delaying display of the data stream is met by the system retuning to the data stream channel (program channel) only after the interactive session has been terminated. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Zigmond et al. advertisements with the Howe et al. interactivity for the purpose of informing a user of the availability of an interactive application relating to the subject matter of a commercial and invoke the application to investigate that subject matter more thoroughly and according to his or her own tastes (Howe et al. 2:48-54).

As to claim 32, the claimed wherein the digital set top box includes both a buffer and a memory and is configured to store those of the selected data sets representing a first one of the information elements in the buffer and others of the selected data sets representing other information elements in the memory. The Zigmond et al. reference discloses the storage of advertisements in memory. However, the Zigmond et al. reference is silent as to the use of a buffer. Nevertheless, the examiner gives Official notice that it is notoriously well known in the art of video display to employ a buffer coupled to memory for the purpose of providing quick access to data to be inserted thus ensuring seamless video segment transitions. Accordingly, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Zigmond et al. display of advertisements stored in memory with the notoriously well known uses of buffer queue for the purpose of providing a method for memory management and the above stated advantages.

As to claim 33, the claimed wherein the digital set top box is further configured to replace those of the selected data sets representing the first one of the information elements in the buffer with at least some of the others of the selected data sets representing other information elements in the memory after displaying the first information element. Please see rejection of claim 32. Note, information is stored in a buffer prior to display, consequently, after an advertisement is displayed, a next advertisement is moved to a buffer for subsequent display.

As to claim 35, the claimed "wherein the information elements comprise one or more of: advertisement, information regarding the data stream information, information regarding a television program, information regarding at television channel, personal information regarding

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the user, a segment of the data stream information, or local or regional information” are met by Zigmond et al. advertisements, please see rejection of claim 31.

As to claim 36, the claimed “wherein the digital set top box is further configured to store the user profile information” is met by “[a]d insertion device 80 includes means for storing...viewer and system information...any of a wide range of household data characterizing the viewer, the geographical location of the household...” (Zigmond et al. 10 :25-34).

As to claims 37 and 38, the claimed wherein the user profile information is stored at the server and wherein the user profile information is stored in a data source accessible by the server. The Zigmond et al. reference discloses storing viewer preference information. However, the Zigmond et al. reference is silent as to profile information stored at the server or on a data source accessible by the server. Nevertheless, the examiner gives Official Notice that it is notoriously well known in the art to store profile information at a server or an external source accessible by a headend such as a external user profile database in order to provide a centralized storage of user profile information. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Zigmond et al. reference accordingly for the purpose of providing targeted advertisements where the profile is stored in a location other than the set top box to broadcast local content that may be of interest to a wider audience using user statistics and at a more centralized location.

As to claim 39, the claimed “wherein the data store unit is further configured to store the data stream information”

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4. Claims 3 and 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US 6,698,020 B1) in further view of Howe et al. (US 5,892,508) and Grossman et al. (US 5,907,321).

As to claim 3, the claimed wherein initiation of the first switching event comprises receiving at the digital set top box a signal from a television remote control device to switch channels. Note the Zigmond et al. and Howe et al. combination teaches interactive advertisements during commercial breaks during programming. However, the Zigmond et al. and Howe et al. combination are silent as to their use during channel changes. Now note the Grossman et al. reference that discloses a method for transmitting and displaying an interchannel interval image in a cable system. The Grossman et al. reference discloses in the method of the present invention a subscriber unit such as subscriber unit 24a displays the visual image received from cable headend 12 on television receiver 30 when a user of subscriber unit 24a changes channels using remote control device 20 (Grossman et al. 3:41-45). The Grossman et al. reference also discloses in decision 90 a determination is made whether the received control signal from remote control device 20 is representative of a channel change command from the user (Grossman et al. 4:55-58), wherein the image can include identification information for later access to a user such as a web page address (Grossman et al. 7:49-60). Therefore the examiner submits it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Zigmond et al. and Howe et al. interactive commercials during commercial breaks with the Grossman et al. advertisements during channel changes for the purpose of extending the embodied concept of interactive advertising to other circumstances as

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taught by Grossman wherein advertisements including sponsor information may be accessed immediately instead of requiring access at a later time using a separate device.

As to claim 34, note the Zigmond et al. and Howe et al. combination teaches interactive advertisements during commercial breaks during programming. However, the Zigmond et al. and Howe et al. combination are silent as to their use during channel changes. Now note the Grossman et al. reference that discloses a method for transmitting and displaying an interchannel interval image in a cable system. The Grossman et al. reference discloses in the method of the present invention a subscriber unit such as subscriber unit 24a displays the visual image received from cable headend 12 on television receiver 30 when a user of subscriber unit 24a changes channels using remote control device 20 (Grossman et al. 3:41-45). The Grossman et al. reference also discloses in decision 90 a determination is made whether the received control signal from remote control device 20 is representative of a channel change command from the user (Grossman et al. 4:55-58), wherein the image can include identification information for later access to a user such as a web page address (Grossman et al. 7:49-60). Therefore the examiner submits it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Zigmond et al. and Howe et al. interactive commercials during commercial breaks with the Grossman et al. advertisements during channel changes for the purpose of extending the embodied concept of interactive advertising to other circumstances as taught by Grossman wherein advertisements including sponsor information may be accessed immediately instead of requiring access at a later time using a separate device.

Conclusion

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5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Judson reference (US 5,572,643) discloses a web browser with dynamic display of information objects during linking.

The Capek et al. reference (US 6,095,677) discloses methods, systems and computer program products for providing insertions during delays in interactive systems.

The Tsuria reference (US 5,786,845) discloses a CATV message display during changing of channels.

The Hayashi reference (US 6,340,987 B1) discloses a method and apparatus for masking latency in an interactive television network.

The Goode et al. reference (US 5,781,227) discloses a method and apparatus for masking the effects of latency in an interactive information distribution system.

The Picco et al. reference (US 6,029,045) discloses a system and method for inserting local content into programming content.

The Hooks et al. reference (US 6,169,542 B1) discloses a method of delivering advertising through an interactive video distribution system.

The Neel et al. reference (US 5,838,314) discloses a digital video services system with optional interactive advertisements capabilities.

The Nathan et al. reference (US 6,182,126 B1) discloses a home digital audiovisual information recording and playback system.

The Kitsukawa et al. reference (US 6,282,713 B1) discloses a method and apparatus for providing on-demand electronic advertising.

The Klug et al. reference (US 6,615,251 B1) discloses a method for providing node targeted content in an addressable network.

The Shaw et al. reference (US 6,199,106 B1) discloses electronic mail system with advertising.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (703) 305-8099. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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